

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE
TTAB

Mailed: April 20, 2004
Paper No. 8
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SK Telecom Co., Ltd.

Serial No. 78101321

Anthony J. Park, Esq. of McKenna, Long & Aldridge, LLP for
SK Telecom Co., Ltd.

Florentina Blandu, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Walters, Chapman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 7, 2002, SK Telecom Co., Ltd. (applicant)
applied to register the mark CELLPLAN (typed) on the
Principal Register for goods ultimately identified as:

computer software used for the transmission of
electronic signals for wireless telephone, computer
programs used for the transmission of electronic
signals for wireless telephone, computer operating
programs, computers, sound wave telegraph sets,
carrier relay equipment, pagers and communication
servers for computer hardware, wireless telephone,
telephone transmitters of electronics signals in
International Class 9.

The application is based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney has refused to register applicant's mark on the ground that if the mark was used on or in connection with the identified goods, it would so resemble the registered mark:



for "telecommunications services, namely installation and operation of point to point radio systems" in International Class 38 and "design and installation of computer software for use in telecommunications" in International Class 42¹ as to be likely to cause confusion, to cause mistake or to deceive. 15 U.S.C. § 1052(d). The registration contains a disclaimer of the words "Wireless Global Technologies."

When the refusal was made final, applicant filed a notice of appeal.

¹ Registration No. 2,014,985 issued November 12, 1996, affidavits under Section 8 and 15, accepted and acknowledged.

The examining attorney argues that applicant's and registrant's marks are very similar and the applicant's goods and registrant's services are closely related.

Applicant submits that its marks and the registrant's mark are dissimilar. Regarding the goods and services, applicant maintains that "the goods claimed by the Applicant's Mark are clearly dissimilar to the services claimed by the Registrant's Mark." Applicant's Brief at 2 (emphasis deleted).

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first look at the similarities or dissimilarities of the marks. Applicant's mark is for a single word

CELLPLAN in typed form. The registered mark contains the same word with a single letter "l" and the words "Wireless Global Technologies" and a design. When the mark is viewed, the word "CelPlan" is displayed in significantly larger type than the disclaimed words.



The words CELPLAN and CELLPLAN would likely be pronounced identically. Applicant's mark consists only of the word CELLPLAN and the registered mark is dominated by this word. In addition to being phonetically identical, these words appear nearly identical inasmuch as many potential customers may not even notice the lack of an additional letter "l" in the registered mark. Also, these words would have no discernable difference in meaning. Inasmuch as applicant's mark is depicted in typed form, any difference in stylization of the marks is not legally significant. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

We have also considered the disclaimed matter in the registered mark, but we are not persuaded that potential customers would use this matter to distinguish the marks of the applicant and registrant. "Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). See also In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (Disclaimed matter is often "less significant in creating the mark's commercial impression"). In this case, the presence of the visually subordinate, disclaimed matter in the registered mark would not take away from the prominence of the word CELPLAN. In addition, inasmuch as applicant's goods include software for wireless telephones, registrant's words "wireless global technologies" would also be relevant in the context of applicant's goods. Finally, we have considered the design element in registrant's mark. This simple box design would be unlikely to make the marks dissimilar in the eyes of prospective purchasers.

Nonetheless our task is not to simply consider the individual elements of the marks, particularly registrant's, in determining whether there is a likelihood of confusion. Rather, we must consider the marks in their entirety to determine if they are similar. In this case, when we consider the marks CELLPLAN and CELPLAN WIRELESS GLOBAL TECHNOLOGIES and design, we conclude that they are similar. The differences, primarily the presence of disclaimed matter and a design in the registrant's mark, do not detract from the overall similarity of marks that are both dominated by the virtually identical word CELPLAN or CELLPLAN. This term is the prominent feature of the marks and it would be the term that would be used by customers to identify the goods or services. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there was a likelihood of confusion). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Another important factor in a likelihood of confusion determination is the similarity of the goods and services

of the applicant and registrant. Applicant's goods are identified as:

computer software used for the transmission of electronic signals for wireless telephone, computer programs used for the transmission of electronic signals for wireless telephone, computer operating programs, computers, sound wave telegraph sets, carrier relay equipment, pagers and communication servers for computer hardware, wireless telephone, telephone transmitters of electronics signals in International Class 9.

Registrant's services involve "telecommunications services, namely installation and operation of point to point radio systems" in International Class 38 and "design and installation of computer software for use in telecommunications" in International Class 42.

Applicant argues that the examining attorney erred in finding that applicant's and registrant's goods and services are related because the term "telecommunications field" is "so broad and vague that it is impossible to know whether it relates to cellular phones" and because "the Registrant's Mark simply does not claim any matter that would even suggest involvement with cellular telephones." Applicant's Brief at 2. First, the term "telecommunications field" is certainly broad enough to include cellular or wireless telephones.² Therefore,

² "Telecommunications - 1. Meaningful wired/cabled or wireless transmission and receipt of signals over distance." Petersen,

registrant's telecommunications services would encompass wireless telecommunications services.

Second, the examining attorney has submitted evidence from registrant's website that indicates that registrant identifies itself as "a leading provider of wireless network planning and system optimization software."

Another website page is entitled "CelPlan Wireless Global Technologies is providing sophisticated solutions [for] tomorrow's wireless world ... today!" and begins by referring to the "wireless communications industry." Applicant correctly argues that "the scope of protection of a registered mark is dictated by the claim of its services and not by the scope of the registrant's business activities." Applicant's Brief at 2. We agree with applicant that we must consider the registrant's services as they are described in the identification of services in the registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may

Data Telecommunications Dictionary (1999). We take judicial notice of this definition. University of Notre Dame du Lac v.

reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

However, the examining attorney's evidence was not used to expand the registrant's services to show that the registrant was using the cited marks on additional services. Instead, the evidence makes it clear that registrant's telecommunications services are in fact being used in the wireless telephone field; the specific field where applicant's goods would be used.³ Wireless telephones are a form of telecommunications and, thus, applicant's software for transmitting signals by wireless telephones and registrant's designing and installing software for telecommunications would include installing wireless communication software.

The question is not whether the goods and services are identical or even used together but whether prospective purchasers would assume that the goods of applicant and the services of registrant come from, or are associated with, the same source. Here, at least some of the prospective purchasers of applicant's software for use with wireless

J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ The disclaimed matter in the cited registration "wireless global technology" also indicates that registrant's

telephone services would likely be identical to purchasers of registrant's services of installing software for use in the wireless telecommunications field. Therefore, we agree with the examining attorney that the goods and services are related and that the purchasers would likely include many of the same purchasers.

Finally, applicant argues that it is "a leader in the area of the development of new technologies for the transmission of systems and methods of delivery of signals for wireless phones. It is an elite and small group of companies worldwide that is capable of developing the standards by which cell phones operate." Applicant's Brief at 2-3. Even if the purchasers are sophisticated, it would not lead to a conclusion that there was no likelihood of confusion. "Human memories even of discriminating purchasers ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Here the marks contain such similar, dominant words, CELPLAN and CELLPLAN, and the services and goods are so closely related, that even these purchasers would likely be

telecommunications services are directed toward the wireless telecommunications field.

confused. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ("[E]ven careful purchasers are not immune from source confusion").

The record in this case leads us to conclude that when applicant's and registrant's marks are used on the identified goods and services, confusion would be likely. If we had any doubts, which we do not, we resolve them, as we must, in favor of the prior registrant and against the newcomer. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The examining attorney's refusal to register applicant's mark CELLPLAN for the identified goods because of the cited registration on the ground that it is likely to cause confusion is affirmed.